

AMENDMENT UNDER 37 C.F.R. § 1.116
Application No.: 10/659,817
Attorney Docket No.: Q77969

REMARKS

Claim 13 is amended to include the limitations from claim 14, and claim 14 is canceled. Hence, Claims 1-13 and 15 are all the claims pending in the application.

Claim Rejections - 35 U.S.C. § 102

Claims 1-6 are rejected under 35 U.S.C. § 102(e) as being anticipated by Berthiaume (US 6,772,061). Applicant respectfully traverses the rejection.

Claim 1 is directed to an apparatus for preventing an unqualified person from driving a vehicle. The claim recites a marker detector provided in a vehicle to detect a qualified person marker held by a driver “only when the driver holds the qualified person marker opposite the marker detector.”

In the Office Action it is asserted that Berthiaume anticipates claim 1 because that reference allegedly discloses a person holding the key 110 and that “the key is placed in a predetermined physical relation to the data port.”

To anticipate a claim, the reference must teach every element of the claim. See MPEP § 2131. Moreover, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989), cited in MPEP § 2131.

It is respectfully submitted that the rejection of claim 1 ignores the limitation in that claim of detecting a qualified person marker held by a driver “only when the driver holds the qualified person marker opposite the marker detector.” Berthiaume does not disclose this limitation of claim 1. Berthiaume is directed to controlling a vehicle’s performance level in

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which a key for the vehicle supplies a control signal that indicates one of plurality of performance levels at which the vehicle is to operate. The key 110 disclosed in Berthiaume is structured so that the key 110 mounts to a data port 120 to operate a vehicle. See col. 6, lines 40-42 and Fig. 7B. As shown in Fig. 7B, to operate the vehicle the key mounts onto the data port. Thus, a user would not hold the key while the key is mounted to the data port because the mounting holds the key onto the data port. Accordingly, Berthiaume does not disclose a qualified person marker held by a driver for driving a vehicle only when the driver holds the qualified person marker opposite a marker detector as required by claim 1.

Claims 2-6 are patentable at because of their dependency on claim 1.

Claim Rejection - 35 U.S.C. § 103

Claims 7-15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Berthiaume in view of Roed (US 2005/0140513).

Claim 7 is patentable at least because of its dependency upon claim 1, and since the secondary reference does not satisfy the deficiency in Berthiaume discussed above.

Claim 8 is directed to an apparatus for preventing an unqualified person from driving a vehicle. The claim recites a marker detector provided in a floor of a cab of the vehicle to detect a qualified person marker detector provided in a shoe worn by a driver, and a control unit for monitoring an output from the marker detector.

Berthiaume, as discussed above, discloses a key that provides a control signal for controlling the performance level of a vehicle. Roed is directed to a method of determining if a person is located within the working range of a particular machine. See paragraph [0001] of

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Roed. Roed discloses a machine shop floor equipped with transponders embedded within the floor and a person with a shoe that contains a transceiver. See paragraphs [0009] and [0011].

The Examiner admits that Berthiaume fails to disclose providing a marker detector in the floor of a cab and providing a marker in a shoe worn by a driver. However, Roed is cited for disclosing providing a marker detector in a floor and providing a marker in a shoe. The rationale for asserting that it would have been obvious to combine the references is that allegedly having a “transmitter attached to a personal item of the driver, particularly the shoe of the driver,” would provide “for ease of transport, and to reduce the possibilities of losing the transmitter, and to place the receiver near the driver, namely the cab.” See page 6 of the final Office Action. In the final Office Action, at page 10, it is asserted that the prior art does not teach or suggest combining the references, merely by concluding that “one would have combined the teachings of Berthiaume and Roed to provide a marker and marker detector in a vehicle’s floor, and a qualified person having driving qualification holding the marker.”

Applicant respectfully traverses the rejection because the prior art neither teaches nor suggests modifying the teachings of Berthiaume to place the key in a user’s shoe. The assertion that a person of ordinary skill in the art would have been motivated to modify Berthiaume’s vehicle key based on Roed’s wholly non-analogous art concerning machine shop safety is not supported in the prior art. Rather, it appears that the Examiner engages in impermissible hindsight reasoning, picking and choosing among disclosure in the prior art, using Applicant’s disclosure as a template to arrive at the claimed invention. This type of hindsight reasoning is

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improper to support an obviousness rejection. Accordingly, Applicant respectfully traverses the rejection.

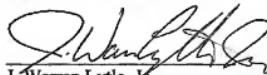
Claim 12 is amended to include the limitations from claim 14, which are directed to the qualified marker being disposed in the shoe of a driver. Claim 12, as amended, is patentable for at least the same reasons as is claim 8, discussed above.

The remaining claims are patentable at least due to their dependency from one of the independent claims discussed above.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


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